

REMARKS

Claims 1-21 are pending. Claims 1-21 stand rejected in the Office Action mailed November 18, 2002. Claims 1,8, 10-13 and 21 have been amended within the subject matter of the application as filed. No new matter has been added.

Claims 1-7 are rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent 3,981,091 of Dammond, Jr., et al. ("Dammond").

Claims 8-21 are rejected under 35 U.S.C. §103(a) as being unpatentable over Dammond in view of U.S. Patent 905,951 of Atkinson ("Atkinson").

Claims 8-10, 12 and 14-21 are rejected under 35 U.S.C. §103(a) as being unpatentable over Dammond in view of U.S. Patent 4,010,517 of Miller et al ("Miller").

Rejections under 35 U.S.C. §102(b)

The Examiner has rejected claims 1-7 under 35 U.S.C. §102(b) as being anticipated by Dammond. Applicant submits that claims 1-7 are not anticipated by Dammond. In regard to the rejection of claims 1-7, the Examiner has stated in part that:

Dammond teaches a picture holder comprising a front picture retaining member 14, a rear picture retaining member 16, an upper U-shaped clamping member 10 and a lower U-shaped clamping member 12. The upper and lower members are adapted to clamp the upper and lower edges of the picture retaining members. (11/18/02, Office Action, p. 2)

Applicant respectfully submits that claims 1-7 are not anticipated by Dammond. Amended claim 1 recites the feature of a "u-shaped clip for securing said overlay sections together..." (Emphasis added) Dammond does not disclose a U-shaped clip. Dammond discloses a picture holder having a "C-shaped clamping member 64," not a u-shaped clip as claimed by applicant's claim 1. (Dammond, col. 2, ll. 59-66). Dammond's C-shaped clamping member is required to be "C-shaped" because the upper C-shaped "clamping member must be slid from one side of the juxtaposed front picture member...along the grooves 18 and 20 with the elongated projecting members 22 and 24 within the grooves...until the projecting members 22

and 24 completely fill the grooves....” (Dammond, col. 1, ll. 70-75). Therefore, Dammond does not disclose a u-shaped clip as claimed by applicant.

The Examiner also states that: “The picture holder taught by Dammond may rest on the bottom of the lower channel member 12. (Col. 2, lines 39-40)” However, Dammond states that since picture frame A could not stand on the bottom of a clamping member 64, suitable support would normally be provided. (Dammond, col. 2, ll. 66-68). Thus, Dammond does not disclose “at least one securing platform to support said overlay section set” as claimed in applicant’s claim 1.

Additionally, Dammond’s picture holder is configured such that “the ends 26 and 28 of the upper clamping member 10 are flush with the sides 30, 32, and 34, 36 of the front and back picture retaining members 14 and 16, respectively....” (Dammond, col. 2, ll. 1-4). Dammond, therefore, does not disclose a “u-shaped clip for securing said overlay sections together at a point near an edge of the overlay section set....” (Claim 1) (emphasis added).

Because Dammond does not disclose the features of “at least one u-shaped clip,” “at least one securing platform,” or “securing said overlay sections together at a point near an edge of the overlay section set” as taught by claim 1, applicant respectfully submits that claim 1 is not anticipated under 35 U.S.C. §102(b) by Dammond.

Furthermore, because Dammond does not disclose this feature as taught by applicant and given that claims 2-7 depend directly or individually from claim 1, applicant respectfully submits that claims 1-7 are not anticipated under 35 U.S.C. §102(b) by Dammond.

Rejections Under 35 U.S.C. §103

The Examiner has rejected claims 8-21 under 35 U.S.C. §103(a) as being unpatentable over Dammond in view of Atkinson.

In regard to the rejection of claims 8-21, applicant respectfully submits that claims 8-21 are not obvious in view of the combination of Dammond and Atkinson. It is respectfully

submitted that it would be impermissible hindsight, based on applicant's own disclosure, to combine Dammond and Atkinson. Dammond and Atkinson do not teach or suggest a combination with each other. Dammond provides for c-shaped members that follow a groove along an entire edge of a specific rear panel configured to receive it. (Dammond, Fig. 1, Abstract) Atkinson discloses a knockdown picture frame consisting of "connecting means" for holding up panels. (Atkinson, p. 1, ll. 50-57) Dammond's picture holder serves a completely different purpose than Atkinson's panel connecting means. Neither reference suggest a combination with each other, let alone describe a u-shaped clamp.

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

However, nowhere is there any indication that the references provide any motivation for the recited combination. Instead, it appears the teachings of the present application have been used as a blueprint to gather together and assemble various components of the prior art in the manner contemplated by applicant. This is a classic example of the use of hindsight reconstruction, and cannot properly be used as grounds for rejecting the present claims.

The U.S. Court of Appeals for the Federal Circuit has strongly criticized such applications of hindsight by specifically indicating that when an obviousness determination is made based upon a combination of references, even a patent examiner "must show reasons that the skilled artisan, confronted with the same problems as the inventor *and with no knowledge of the claimed invention*, would select the elements from the cited prior art references for combination in the manner claimed." *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998) (emphasis added). Merely indicating, as the Examiner argues in its motion, that the claimed invention would be obvious to one of ordinary skill in the art based on the combination of the references is utterly inadequate. *Rouffet*, at 1357. Instead, what is needed is a showing of

motivation, either from the references themselves or the knowledge of those of ordinary skill in the art, for the combination being relied upon. *Rouffet* at 1357.

In the present case, there has been no showing of such motivation. Instead, the Examiner attempts to deconstruct the subject matter of the claims of the present application into its constituent components, states where each such component may be found in one of the cited references, and then concludes that it would have been obvious to combine the references to arrive at the claimed invention. This bare bones analysis is not sufficient to support a determination of obviousness. The burden is on the Examiner to show *why* one be so motivated as to come up with the combination being relied upon. *Rouffet*, at 1357-1358 ("If such a rote invocation could suffice to supply a motivation to combine, the more sophisticated scientific fields would rarely, if ever, experience a patentable technical advance. Instead, in complex scientific fields [an infringer or the Patent Office] could routinely identify the prior art elements in an application, invoke the lofty level of skill, and rest its case for [obviousness]. To counter this potential weakness in the obviousness construct, the suggestion to combine requirement stands as a critical safeguard against hindsight analysis and rote application of the legal test for obviousness.")

In regard to the rejection of claims 8-21, the Examiner has stated that:

Atkinson teaches a knockdown picture frame comprising a first clip member and a second clip member hingedly holding a pair of adjacent panels at connection c....It would have been obvious...to construct the picture holders taught by Dammond with a double hinged clip as taught by Atkinson....
(11/18/02, Office Action,, p.3)

In any event, even if Dammond and Atkinson were combined, such a combination would lack one or more features of the rejected claims. Amended claim 8 includes the feature of "at least one double-u-shaped clip for securing said overlay section sets together at a point near an edge of the overlay section set..." (Emphasis added) Neither Dammond nor Atkinson disclose this feature. Dammond discloses a "c-shaped clip" that traverses entire edges of the picture frame. (Dammond, col. 2, ll. 59-67). Atkinson discloses connecting means to interconnect

panels, but does not disclose “securing said overlay section sets together...” as claimed by applicant in claim 8. A combination of Dammond and Atkinson would lack the feature of at least one double u-shaped clip for securing said overlay section sets together. (claim 8) Because the combination of Dammond and Atkinson does not disclose this feature as taught by applicant and given that claims 8-21 depend directly or individually from independent claim 8 and add additional limitations, it is respectfully submitted that claims 8-20 are not unpatentable under 35 U.S.C. §103(a) in view of Dammond and Atkinson.

The Examiner also rejected claim 21 under 35 U.S.C. §103(a) for the reasons set forth in the rejection of claims 8-20. Claim 21 discloses substantially similar limitations as claim 8 and recites the feature of “at least one double-u-shaped clip connecting said first overlay section set to said second overlay section set at a point near an edge of the first overlay section set...” (emphasis added) A combination of Dammond and Atkinson would lack this feature for the reasons discussed above with regard to claims 8-20, applicant respectfully submits that claim 21 is not obvious under 35 U.S.C. §103(a) by Dammond in view of Atkinson.

The Examiner has rejected claims 8-10, 12, and 14-21 under 35 U.S.C. §103(a) as being unpatentable over Dammond in view of Miller.

In regard to the rejection of claims 8-10, 12, and 14-21, applicant respectfully submits that claims 8-21 are not obvious in view of the combination of Dammond and Miller. It is respectfully submitted that it would be impermissible hindsight, based on applicant's own disclosure, to combine Dammond and Miller. Dammond and Miller do not teach or suggest a combination with each other. Dammond provides for c-shaped members that follow a groove along an entire edge of a specific rear panel configured to receive it. (Dammond, Fig. 1, Abstract) Miller discloses a c-shaped display device (Miller, Figures 1-9). Dammond's picture holder serves a completely different purpose than Miller's display device since Miller's display

device does not contemplate joining front and back members as does Dammond. Neither reference suggest a combination with each other, let alone describe a u-shaped clamp.

In regard to the rejection of claims 8-10, 12, and 14-21, the Examiner has stated that:

Miller teaches a display device comprising a double clip 21 for holding a pair of display panels. It would have been obvious to construct the picture holder taught by Dammond with a double clip as taught by Miller....
(11/18/02, Office Action,, p.3)

In any event, even if Dammond and Miller were combined, such a combination would lack one or more features of the rejected claims. Amended claim 8 includes the feature of “at least one double u-shaped clip for securing said overlay section sets together...” (Emphasis added) Neither Dammond nor Miller disclose this feature. Both Dammond and Miller describe C-shaped clips (Dammond, Figs. 1-2, Miller, Figs. 2-9). The differences between u-shaped and c-shaped clips are described above. A combination of Dammond and Miller would lack the feature of at least one double u-shaped clip for securing said overlay section sets together. (claim 8) Because the combination of Dammond and Miller does not disclose this feature as taught by applicant and given that claims 8-10, 12, and 14-20 depend directly or individually from independent claim 8 and add additional limitations, it is respectfully submitted that claims 8-10, 12, and 14-20 are not unpatentable under 35 U.S.C. §103(a) in view of Dammond and Miller.

The Examiner also rejected claim 21 under 35 U.S.C. §103(a) for the reasons set forth in the rejection of claims 8-10, 12, and 14-21. Claim 21 discloses substantially similar limitations as claim 8 and recites the feature of “at least one double u-shaped clip connecting said first overlay section set to said second overlay section set...” (emphasis added) A combination of Dammond and Miller would lack this feature for the reasons discussed above with regard to claims 8-20, applicant respectfully submits that claim 21 is not obvious under 35 U.S.C. §103(a) by Dammond in view of Miller.

Applicant respectfully submits that all rejections have been overcome. Consideration of this amendment should lead to favorable action that would overcome all remaining grounds of objection and/or rejection.

If there are any additional charges, please charge Deposit Account No. 02-2666.

Respectfully submitted,
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